

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated October 19, 2006 (hereinafter Office Action) have been considered but are believed to be improper for the reasons presented below. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Applicant respectfully traverses each of the §103(a) rejections, each of which relies at least in part upon a combination of the teachings of U.S. Publication No. 2002/0013774 by Morimoto (hereinafter “Morimoto”) in view of U.S. Publication No. 2005/0246541 by Ginter *et al.* (hereinafter “Ginter”), because the asserted references, alone or in combination, do not teach or suggest each of the claimed limitations. For example, neither of these asserted references teaches a trusted server that prepares a contract for a transaction between a merchant system and a buyer system. The personal broker-agent program of Morimoto does not prepare a contract between a buyer and merchant system as any contract between the buyer and merchant is instead prepared by the buyer who indicates the terms and a merchant who is willing to meet, or beat, those terms via an auction. Similarly, the electronic go-between of Ginter merely passes offers between two parties to supervise the creation of a contract (paragraph [0694], line 17). Neither reference teaches an impartial intermediary preparing a contract and sending the prepared contract to the buyer system. As neither of these references teaches these limitations, any combination of these references must also fail to correspond to such limitations. Without a presentation of correspondence to each of the claimed limitations, the §103(a) rejections are improper and should not be maintained.

Applicant also notes that neither Morimoto nor Ginter appear to teach a charging engine, as claimed. The Examiner’s citation to Morimoto merely refers to a portion of Claim 29 which describes purchasing an item on behalf of a purchaser and charging the purchaser a new price. This cited portion makes no mention of calculating a charge, or that the charge is to be paid to the merchant system by the user (purchaser). Rather, the charge in Morimoto is paid to the personal broker-agent which purchased the item on the purchaser’s behalf. Also, Ginter does not appear to teach a charging engine, as claimed, as

the discussion of charging indicates that the electronic go-between (the asserted trusted server) handles those transaction aspects, and no separate charging engine is disclosed.

Dependent Claims 2-15, 23-27, 33-40, 51, 52, 61 and 62 depend from independent Claims 1, 22 and 60, respectively. Each of these dependent claims also stand rejected under 35 U.S.C. §103(a) as being unpatentable over the above-discussed combination of Morimoto and Ginter. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the remarks made in connection with independent Claims 1, 22 and 60. These dependent claims include all of the limitations of their respective base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." MPEP §2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2-15, 23-27, 33-40, 51, 52, 61 and 62 are also allowable over the asserted combination of Morimoto and Ginter.

With particular respect to the rejection of dependent Claims 62 and 63, Applicant notes that no evidence, in the form of citations or otherwise, of correspondence has been presented. For example, no portion of Morimoto has been shown to teach validating a buyer signature associated with an accepted contract. Applicant also fails to recognize the relevance of the citation to *In re Schreiber* as the dependent claim limitations are not directed to a new use for any asserted old product. Without a presentation of correspondence to each of the claimed limitations, the §103(a) rejection is improper. Applicant accordingly requests that the rejection be withdrawn.

Without acquiescing to characterizations of the asserted art, Applicant's claimed subject matter, or to the applications of the asserted art or combinations thereof to Applicant's claimed subject matter, and in an effort to facilitate prosecution, Applicant has amended the independent claims to characterize that the contract prepared by the trusted server is sent to the merchant system before being sent to the buyer system by the trusted

server. Support for these changes may be found, for example, in Figs. 2 and 3, and at page 13, lines 5-7 of the Specification. The asserted references do not teach these limitations as, for example in Morimoto, any contract is initially created with the purchaser's terms before the merchant is identified; therefore, the merchant does not view any prepared contract before the purchaser. The cited portion of Ginter also teaches that a contract is initiated by the buyers. As the cited references, alone or in combination, fail to correspond to the invention as claimed, Applicant submits that the claims are allowable and the rejections should be withdrawn.

In addition to having to show that the asserted combination of references teaches or suggests all of the claim limitations, the Examiner must show evidence of motivation to combine these references as asserted. Applicant respectfully submits that this requirement has not been met.

The requisite evidence of motivation to combine the cited references as asserted has not been presented, nor does such motivation exist based on the cited references. In the Office Action, the proffered motivation to modify Morimoto to include an impartial intermediary is to help "coordinate and complete a complex contractual arrangement." However, Morimoto is not directed to complex contractual arrangements, but rather is directed to finding a merchant to provide a better price or deal for a product that is about to be purchased. Moreover, the proffered motivation is not evidence of motivation to combine the asserted references, but rather, is a generalized statement of what is asserted as being taught by Ginter. No evidence has been provided that a skilled artisan would have attempted to introduce Ginter's electronic go-between to the teachings of Morimoto.

Moreover, the asserted modification of Morimoto would improperly render the teachings of Morimoto unsatisfactory for their intended purpose. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *See, In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP §2143.01(V). Morimoto is directed to a biased broker system that negotiates a better deal for a buyer's benefit. However, the Examiner proposes replacing Morimoto's biased system

with an asserted impartial electronic go-between as taught by Ginter. Because a buyer in Morimoto has already made a decision to purchase a product, an impartial electronic go-between would not be necessary, and the impartial go-between could not negotiate improved terms for the buyer due to its alleged impartiality. *See*, paragraph [0011]. A skilled artisan would not be motivated to modify Morimoto as asserted because the proposed modification would render the teachings of Morimoto unsatisfactory for its intended purpose of negotiating improved terms on a buyer's behalf.

The examiner must show some objective teaching leading to the asserted combination. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). Since neither Morimoto nor Ginter teach an impartial intermediary preparing a contract, as discussed above, it is respectfully submitted that the teachings of Morimoto and Ginter would have provided insufficient guidance for a skilled artisan having these references before him/her to make the combination suggested by the Examiner. Applicant respectfully asserts that the Examiner's conclusion of obviousness is, instead, based on improper hindsight reasoning using knowledge gleaned only from Applicant's disclosure. As stated by the Federal Circuit:

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.

In re Dembiczak, 50 USPQ2d 1614, (Fed. Cir. 1999) (*citing Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985)). Without a suggestion of the desirability of "the combination," a combination of such references is made in hindsight, and the "range of sources available, however, does not diminish the requirement for actual evidence." *Id.* It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown and that this evidence be "clear and particular." *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

There is nothing in the references or what is in the ordinary skill in the art that would lead to combining the cited references as asserted – rather, the proffered motivation is made in hindsight. For at least the aforementioned reasons, Applicant respectfully

submits that a case of *prima facie* obviousness has not been satisfied for lack of a presentation of evidence of motivation to combine the cited references. Applicant accordingly requests that the rejections be withdrawn.

With respect to the other §103(a) rejections of various dependent claims based further upon the teachings of U.S. Publication No. 2003/0078862 by Kojima *et al.* (hereinafter “Kojima”); U.S. Publication No. 2002/0107785 by Melchior *et al.* (hereinafter “Melchior”); and U.S. Patent No. 6,064,987 to Walker *et al.* (hereinafter “Walker”), respectively, Applicant traverses because the Examiner’s reliance upon these teachings does not overcome the above-discussed deficiencies in the asserted combination of Morimoto and Ginter. No teachings have been cited in Kojima, Melchior, or Walker that correspond to the claimed preparation of a contract. Thus, without a presentation of correspondence to each of the claimed limitations, these §103(a) rejections are also improper and should be withdrawn.

With particular respect to the rejection of Claim 54, Applicant fails to recognize how the asserted claim limitations are descriptive material and maintains that the limitations directed to a charging engine that processes charging data to be made in multiple increments, where the multiple increments correspond to multiple events occurring according to the transaction are not descriptive material. While, the Examiner has stated that “this difference is only found in the nonfunctional descriptive material and is not functionally involved in the system,” charging in multiple increments corresponding to multiple events occurring in accordance with the transaction is functionally a part of one embodiment of the system and is patentable over the asserted combination of references. The Examiner’s reliance on limitations of further dependent claims is not understood with respect to the rejection of Claim 54.

Applicant also maintains that limitations directed to ceasing further buying in dependent Claims 56-58 are not inherent in Morimoto. In accordance with MPEP §2112, Applicant requested that extrinsic evidence be provided that would show that Morimoto inherently teaches the asserted inherent limitations. The Examiner has not provided any such evidence. Moreover, the Examiner’s assertion that “once a payment is received, the

buying process is finished” is incorrect. The receipt of a partial payment does not complete a buying process. The Examiner has not shown that the claimed limitations are necessarily present in Morimoto. Without a presentation of correspondence to each of the claimed limitations, the §103(a) rejection of these claims is improper. Applicant accordingly requests that it be withdrawn.

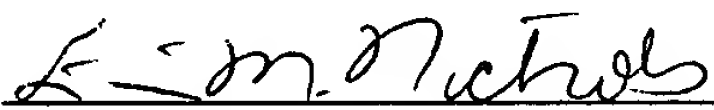
It is to be understood that Applicant does not acquiesce to the Examiner’s characterization of the asserted art or Applicant’s claimed subject matter, nor of the Examiner’s application of the asserted art or combinations thereof to Applicant’s claimed subject matter. Moreover, Applicant does not acquiesce to the Examiner’s statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, inherent steps, obvious design choices, common knowledge at the time of Applicant’s invention, officially noticed facts, and the like. Applicant reserves the right to address in detail the Examiner’s characterizations, conclusions, and rejections in future prosecution.

Authorization is given to charge Deposit Account No. 50-3581 (NOKV.008PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700

Date: January 19, 2007

By: 
Erin M. Nichols
Reg. No. 57,125